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10/17/90

This application has been examined Responsive to communication filed on 4/26/90 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.
3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.	4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152
5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.	6. <input type="checkbox"/> _____

Part II SUMMARY OF ACTION

1. Claims 1-12 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 13 have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-12 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

The reissue declaration filed with this application is defective because it states that the discovery of the error was caused by the development of a new embodiment after the patent had issued. The purpose of a Reissue Application is to correct errors that occur during prosecution, not to cover newly developed embodiments which would have been covered by claims in the original application, which coverage had been intentionally cancelled in order to read over the prior art.

Claims 1-12 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 12 is rejected under 35 U.S.C. § 103 as being unpatentable over Paschal in view of Beck.

Paschal discloses everything claimed with the possible exception of the properties of the elastic material. Paschal does state that his enclosure can be made from "flexible plastic material or any other suitable flexible material which is impervious to liquid". Beck teaches the use of rubber as the elastic material for a lubricant filled massaging device similar to the type disclosed by Paschal. In view of the teachings of Paschal and Beck it would have been obvious to one of ordinary skill in the art to use rubber for the elastic material of Paschal because of its known suitability for such a use. To select any particular rubber known at the time of Applicants' invention based on its known properties, including one meeting the property limitations claimed in claim 12 would have been an obvious matter of design choice at the time of Applicants' invention.

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sealed enclosure formed from two pieces of material must be shown or the feature cancelled from the claim. No new matter should be entered.

Applicant's arguments filed April 26, 1990 have been fully considered but they are not deemed to be persuasive.

The case law cited on page 3 of the arguments to support the propriety of the reissue declaration is not persuasive because

these cases address different issues than those at hand in this application. In the Wilder case the claims were narrower than the prior art required. As evidenced by the fact that in Applicants' parent case to this application the claims were amended to limit the scope of the claim to a single piece of material, from no specifics regarding the number of pieces, in ^{, those claims were not narrower than the prior art required} order to read over the art. In addition, the closest prior art has two pieces. As to the Wadlinger case, this reissue recognized an inherent capability of the previously claimed structure, not another embodiment which applicants are trying to claim in the current application.

While it is critical that the error occurred with no deceptive intent, in a Reissue it is also critical that the error occurred during prosecution.

Regarding arguments drawn to the rejections based on art, the issue is not whether use of the materials disclosed by Applicants would have been obvious to one of ordinary skill in the art at the time of invention of Paschal's or Beck's devices, but rather whether it would have been obvious to one of ordinary skill in the art at the time of the invention claimed in the present application. As these materials and their properties were known, and not invented by Applicants, to select them for their properties, which meet the guidelines of Paschal, being flexible and impervious to liquid, would have been obvious to one

of ordinary skill at the time of Applicants' invention. For this reason the affidavits by Professor Ichniowski on what materials existed in the 1930's and 1950's are not persuasive as to the art rejections.

As to the citation of In re Wright, the decision on that case is not final (it being under appeal) and the Office is not, therefore, bound by this case.

The Examiner does not find arguments that the combination of Paschal and Beck is improper to be persuasive because both are in the same art and there is a teaching in the Paschal reference to use any suitable material meeting certain criteria. Beck teaches a particular suitable material meeting that criteria for use in a very similar device.

The affidavit of Wright is drawn only to secondary considerations. When there is a solid rejection based on art, secondary considerations do not make the claims allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION

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IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Randy Shay at telephone number (703) 557-3125.

RS
R. Shay:lf
October 12, 1990



ALAN CANNON
PRIMARY EXAMINER
ART UNIT 338